

REMARKS

Favorable reconsideration and allowance of this application are requested.

At the outset, the Examiner's correction of the Information Disclosure Statement filed on December 7, 2007 and consideration of such information is appreciatively noted by the applicants.

1. Discussion of Amendments

By way of the amendment instructions above, an amended abstract in compliance with MPEP §608.01(b) has been provided.

Claim 1 has been amended so as to include therein the same component identifiers a)-e) as were used in original and now canceled claim 1. In addition, certain clarifying amendments have been made to several of the dependent claims.

Therefore, following entry of this amendment, claims 19-40 will remain pending herein for which favorable action is solicited.

2. Response to 35 USC §112 Issues

Claims 19-40 attracted a rejection under 35 USC §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention. Applicants suggest, however, that the amended claims presented above obviate the rejection advanced under this statutory provision.

Specifically, the inclusion in the amended version of claim 19 if the component identifiers a)-e) provides antecedent basis for those claims which recite such identifiers. Claims 33-35 have been amended so as to be consistent in the preamble with the recitations in claim 19 with respect to the claimed "at least one glycol". Therefore, the rejection of those claims based on a lack of antecedent basis has been mooted.

With regard to independent claim 19, the Examiner asserts that:

“...although the applicants have support in the instant specification of heat transfer liquid concentrates without borate, said specification also appears to be inclusive of borates....Based upon the conflicting teaching in the original specification [at page 5, lines 23-27], it is noted that for the purpose of furthering examination, ‘contains no borates’ [as recited in claim 19] has been interpreted as ‘may contain small amounts of borates.’”

The Examiner is in fact correct that the originally filed specification contemplated that some borate may be present in the concentrate. In fact, the originally filed and now cancelled claim 1 was of sufficient scope so as to cover the presence of borates therein, i.e., since the limitation that the concentrate contained no borate was not present therein. Instead, such a limitation was present in the original and now canceled claim 7.

While the specification did in fact contemplate and the original claim scope covered the presence of some borate in the concentrate, it was also clear in the specification that the presence of borates is clearly not favored as increased glass corrosion could result. Specifically, at page 5, lines 23-27, the specification teaches the following:

“The novel concentrates contain no borate. For the purposes of the present invention, borate may be present in the heat transfer liquids or concentrates, *but then the advantages according to the invention are not achieved* in most cases. In particular, in the presence of strongly alkaline borates, greater glass corrosion is generally to be found, which can assume substantial levels depending on the composition of the liquid.” (emphasis added)

When presenting new independent claim 19, the limitation of prior claim 7 was combined with claim 1. As such, the scope of claim 1 was restricted to a heat transfer liquid concentrate comprised of at least one glycol and components a)-e) and which contained “no borate”.

The Examiner clearly acknowledges that full support exists in the specification as originally filed at page 5, line 23 for an embodiment of a liquid concentrate which is borate-free (i.e., a concentrate with contains “no borate”). Notwithstanding the full unequivocal support for such an embodiment of the invention, the Examiner imports a limitation into claim 19 which, while itself supported by the specification (i.e., that the liquid concentrate may include some amount of borate), is not covered by the clear language of the applicants’ claims. To be sure, the limitation that the liquid concentrate contains “no borate” means exactly that – the liquid concentrate contains “no borate”. It does not mean, as the Examiner proffers that the liquid concentrate may contain small amounts of borate.

It is of course without question the purpose of an applicants’ claims is to define the invention that applicants believe is patentable. *In re Van Geuns*, 26 USPQ2d 1769, 1776 (Fed. Cir. 1993). In addition, the Court has consistently admonished against reading extraneous limitations into a claim from the specification. *E.I. DuPont & Co. v. Phillips Petroleum Co.*, 7 USPQ2d 1129 (Fed. Cir. 1985). It is also axiomatic that applicants for patents may claim less than what was disclosed.¹ In this regard, as noted by the Court in *Andrew Corp. v. Gabriel Electronics*, 6 USPQ2d 2010 (Fed. Cir. 1988):

“Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public.” *Id.* At 2014, citing *McClain v. Ortmayer*, 141 U.S. 419, 423-24 (1891).

¹ Such an axiom in the patent law is not surprising since, as noted previously, it is the applicants’ claims which define the boundaries of the patent rights.

On this latter point, attention is also directed to *In re Wertheim*, 191 USPQ 90 (CCPA 1976), wherein the Court observed:

“Since the patent law provides for the amendment during prosecution of *claims*, as well as the specification supporting claims, 35 USC 132, it is clear that the reference to ‘particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention’ in the second paragraph of 35 USC 112 does not prohibit the applicant from changing what he ‘regards as his invention’ (i.e., the subject matter on which he seeks patent protection) during the pendency of his application.” *Id.* At 97, *citing In re Saunders*, 170 USPQ 213, 220 (CCPA 1971), emphasis in original.

Thus, it is quite evident that no issue under 35 USC §112, second paragraph could possibly be raised by virtue of the applicants’ amendment of their claims to specify that the defined liquid concentrate contains “no borate” (i.e., by combining original claims 1 and 7 as new independent claim 19). Nor can the presently pending claims be interpreted in the manner noted by the Examiner since to do so completely abrogates the language present therein.

Withdrawal of the rejection advanced under 35 USC §112, second paragraph is therefore in order.

3. Response to 35 USC §102 Issues

Claims 19-24 and 33-36 attracted a rejection under 35 USC §102(b) as being anticipated by Ernhardt et al (GB 2 059 432). Applicants respectfully disagree.

Ernhardt et al discloses an anti-freeze composition for coolant liquids comprising borates in amounts of 1 to 4 % by weight (see page 2, line 45 and examples 1 to 3).

The heat transfer liquids according to the claims presently on file are limited to liquids that contain **no borate**. Therefore, the claims presently on file are novel over Ernhardt et al for at least this reason.

Withdrawal of the rejection advanced under 35 USC §102(b) is therefore in order.

4. Response to 35 USC §103 Issues

Claims 25-27² attracted a rejection under 35 USC §103(a) as allegedly being unpatentable over Ernhardt et al in view of Oppenlaender et al (USP 5,064,552), while claims 19 and 28-32 attracted a rejection under this same statutory provision based on the combination of Tachiwa et al (EP 0 299 942) in view of Ernhardt et al. Finally, claims 37-40 have been rejected under 35 USC §103(a) based on Ernhardt et al in view of Smith (USP 4,117,682). Applicants respectfully suggest that none of the rejections advanced under 35 USC §103(a) is appropriate.

In this regard, the comments above are equally germane to the issue of *unobviousness* of the present invention as defined by pending claims 19-40. Specifically, a noted above, the claimed liquid concentrates contain **no borate**. Thus, the combination of Ernhardt et al – which teaches specifically that borates are a necessary component -- with either Oppenlaender et al or Tachiwa et al, would not make “obvious” the presently claimed invention. Moreover, as noted in the Examples of the present application, the presence of borate contributes to substantial glass corrosion as compared to a similar composition in accordance with the present invention which contains no borate. (e.g., Compare Example 1 to Comp. example B).

Therefore, an ordinarily skilled person would not be lead to the presently claimed borate-free glycol-based liquid concentrates based on the combination of publications advanced by the Examiner. Withdrawal of all rejections under 35 USC §103(a) is therefore in order.

² It appears that the Examiner’s statement of rejection of claims 25-26 on page 7, line 5 should have read 25-27” in view of the statement on page 7, line 8.

WENDEROTH et al
Serial No. 10/542,776
August 29, 2008

5. Fee Authorization

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____ /Bryan H. Davidson/
Bryan H. Davidson
Reg. No. 30,251

BHD:dlb
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100